

Appln. No. 10/616,753  
Docket No. 130373/GEN-0346

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## REMARKS / ARGUMENTS

### Status of Claims

Claims 1-39 are pending in the application and stand rejected. Applicant has amended Claims 1 and 22, leaving Claims 1-39 for consideration.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

### Rejections Under 35 U.S.C. §103(a)

**Set-I:** Claims 1, 2, 6, 8, 9, 10, 16, 22, 23, 27, 29, 30, 31 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over H.C. Anderson (U.S. Patent No. 3,440,528, hereinafter Anderson) in view of Kane (U.S. Patent No. 4,614,925, hereinafter Kane).

**Set-II:** Claims 3, 7, 24 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and further in view of Roberts Jr. et al. (U.S. Patent No. 6,661,634 hereinafter Roberts Jr.).

**Set-III:** Claims 4, 5, 17, 25, 26 and 38 are rejected under U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Havot et al. (U.S. Patent No. 5,121,078, hereinafter Havot).

**Set-IV:** Claims 11 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Brandeau (U.S. Patent No. 4,750,266, hereinafter Brandeau).

**Set-V:** Claims 12 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Shimada et al. (U.S. Patent No. 6,020,867, hereinafter Shimada).

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**Set-VI:** Claims 13, 14, 18, 19, 34, 35 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Stahl (U.S. Patent No. 5,388,021, hereinafter Stahl).

**Set-VII:** Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson, in view of Roberts Jr.

**Set-VIII:** Claims 15 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Bender (U.S. Patent No. 6,926,288, hereinafter Bender).

**Set-IX:** Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Kane and Knigge et al. (U.S. Patent No. 6,639,779, hereinafter Knigge).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Furthermore, Applicant respectfully submits that "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing: *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There must also be a reasonable expectation of success in modifying or combining the prior art, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 USPQ2d 1016, 1023 (Fed. Cir. 1996).

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And, there must be some degree of predictability in showing the reasonable expectation of success. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); MPEP §2143.03.

**Regarding Set-I:**

Applicant has amended independent Claims 1 and 22 to now include limitations directed to: *the first conductor and the second conductor being disposed on opposing sides of said circuit card and having an area of overlap between the first conductor and the second conductor; and, the distributed capacitance being readily adjustable to various RF filtering requirements via adjustment of the area of overlap.*

No new matter has been added as antecedent support can be found in the application as originally filed, such as at Paragraphs [0015] and [0028-0030] and at Figure 2, for example.

Dependent claims inherit all of the limitations of the respective parent claim.

In comparing the combination of Anderson and Kane with the claimed invention as amended, Applicant finds the combination to be deficient in teaching each and every element of the claimed invention arranged in such a manner as to perform as the claimed invention performs.

More specifically, Applicant finds the combination of references to be absent any teaching of the first and second conductors, which define both the distributed inductance and the distributed capacitance, being disposed on opposing sides of the circuit card with an area of overlap therebetween, such that the distributed capacitance is readily adjustable to various RF filtering requirements via adjustment of the area of overlap.

Accordingly, Applicant submits that the combination of references fail to teach each and every element of the claimed invention arranged in such a manner as to perform as the claimed invention performs, and therefore do not establish a prima facie case of obviousness.

Furthermore, the claimed invention has the advantage of providing a distributed capacitance that is readily adjustable, thereby addressing issues with existing art that suffers from stray lead inductance and capacitance, and inherent impedance mismatches (see Paragraph [0003] of the originally filed application for example). In comparing the

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teachings of the prior art references with the teachings of the instant application, Applicant finds no motivation in the prior art references to modify the primary reference for solving the problem recognized and solved only by the instant invention. As such, Applicant submits that a prima facie case of obvious cannot be established as the prior art lacks the motivation to arrive at the claimed invention.

**Regarding Sets II-IX:**

In view of the references in Sets II-IX not being applied against the independent claims, the remarks set forth above regarding the allowability of the independent claims, and the fact that dependent claims inherit all of the limitations of the respective parent claim, Applicant submits that all claims in Sets II-IX are allowable at least for the reason that they depend from an allowable claim.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed, thereby resulting in the application being in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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